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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,563	03/31/2004	Zhibin Wang	BEAS-01513US0	6910

23910 7590 04/18/2007	EXAMINER	
FLIESLER MEYER LLP	MITCHELL, JASON D	
650 CALIFORNIA STREET		
14TH FLOOR	ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94108	2193	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/814,563	WANG ET AL.
	Examiner	Art Unit	
	Jason Mitchell	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-21 are pending in this application.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   **Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4.   **The following Claim language is indefinite:**

Independent claims 8 and 15 recite entering "a number of generic test commands or directives". One of ordinary skill in the art would not be able to determine if and/or how 'directives' are functionally distinct from 'generic test commands', or if the term 'directives' is intended to be simply a different label to be used interchangeably with the term 'generic test commands'.

Further, this leads to ambiguities in the dependant claims 11-13, and 18-20 which rely on the antecedent basis provided by this statement (e.g. claim 11 "said test commands").

5.   **The following Claims lack antecedent basis:**

Claim 1 recites the limitation "the directives" in lines 7-8.

Claim 2 recites the limitation "the same computer or machine" in line 2.

Claim 4 recites the limitation "the editor" in line 1.

Claim 4 recites the limitation "said test commands" in line 2.

Claim 5 recites the limitation "the editor" in line 1.

Claim 5 recites the limitation "the test commands" in lines 1-2.

Claim 6 recites the limitation "the test commands" in line 1.

Claim 8 recites the limitation "the generic interface commands" in line 5.

Claim 9 recites the limitation "the system" in line 1

Claim 9 recites the limitation "the same computer or machine" in line 2.

Claim 15 recites the limitation "the generic interface commands" in line 5.

Claim 16 recites the limitation "the system" in line 1

Claim 16 recites the limitation "the same computer or machine" in line 2

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-7 recite various structures each of which could be implemented entirely in software. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional

interrelationships between the computer program and other claimed elements of a

computer, which permit the computer program's functionality to be realized. In contrast,

a claimed computer-readable medium encoded with a computer program is a computer

element which defines structural and functional interrelationships between the computer

program and the rest of the computer which permit the computer program's functionality

to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at

1035. .

Double Patenting

7.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).   .
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.   ·
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).   ·   .

8.   **Claims 1-21 are provisionally rejected on the ground of nonstatutory**

obviousness-type double patenting as being unpatentable over claims 1-21 of

copending Application No. 10/814,200 (the '200 application). Although the

conflicting claims are not identical, they are not patentably distinct from each other

because:

Regarding Claims 1, 8 and 15: Claims 1, 8 and 15 of the '200 application each

explicitly recite the 'interpretive engine', 'native library' and 'editor' claimed in

independent claims 1, 8 and 15. Further, It would have been obvious to one of ordinary

skill in the art at the time the invention was made that loading a different library including

a mapping to a different 'native language' would have allowed support for different test

software suites and applications.

Regarding Claims 2-7, 9-14 and 16-21: Claims 2-7, 9-14 and 16-21 of the '200

application recite language identical to that of instant claims 2-7, 9-14 and 16-21.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claims 1-21 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-21 of

copending Application No. 10/814,546 (the '546 application). Although the

conflicting claims are not identical, they are not patentably distinct from each other

because:

Regarding Claims 1, 8 and 15: Claims 1, 8 and 15 of the '546 application each

explicitly recite the 'interpretive engine', 'native library' and 'editor' claimed in

independent claims 1, 8 and 15. Further, It would have been obvious to one of ordinary

skill in the art at the time the invention was made that loading a different library including

a mapping to a different 'native language' would have allowed support for different test

software suites and applications.

Regarding Claims 2-7, 9-14 and 16-21: Claims 2-7, 9-14 and 16-21 of the '546

application recite language identical to that of instant claims 2-7, 9-14 and 16-21.

This is a provisional obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   **Claims 1, 3-6, 8, 10-13, 15 and 17-20 are rejected under 35 U.S.C. 102(b) as**

being anticipated by US 7,117,411 to McNeely et al. (McNeely).

11.   **Regarding Claims 1, 8 and 15:** McNeely discloses providing a generic user

interface testing framework, comprising the steps of:

allowing a tester to enter a number of generic test commands or directives via an

editor or interface (col. 4, lines 30-33 "a fully integrated test case and test plan editor";

col. 13, lines 23-27 "execution manager 316 may communicate with a ... GUI-type

interface"); and

translating, using an interpretive engine, the generic interface commands

received from the tester (col. 15, lines 47-60 "an abstract command language

command"), and mapping, using a native library (col. 15, lines 47-60 "communication

interface package that ... contains the abstract-command-language-to-tool-command-

language mapping information"), the generic commands to native language understood

by a particular test software tool (col. 15, lines 47-60 "interpret the command and

produce an equivalent tool command language command");

wherein the interpretive engine uses the native library to map the directives into

tool-dependent codes that are then passed to the test software tool (col. 16, lines 6-9

"the resulting tool command language command is subsequently passed to the

communication interface 420"), and

wherein libraries can be loaded to support different test software suites and

applications (col. 13, lines 47-49 "a suitable GUI tester is added via a new package").

12.   **Regarding Claims 3, 10 and 17:** The rejections of claims 1, 8 and 15 are

incorporated respectively; further McNeely discloses the test software tool is stored at

another computer or machine (Fig. 3).

13.   **Regarding Claims 4, 11 and 18:** The rejections of claims 1, 8 and 15 are

incorporated respectively; further McNeely discloses the editor provides a graphical

interface to allow the tester to enter said test commands (col. 12, lines 2-5 "Editor 314 is adapted to interface with the graphical user interface 310").

14.　　**Regarding Claims 5, 12 and 19:** The rejections of claims 1, 8 and 15 are incorporated respectively; further McNeely discloses the editor communicates the test commands as a script of directives (col. 3, lines 20-21 "a test case may be a file of commands or directives").

15.　　**Regarding Claims 6, 13 and 20:** The rejections of claims 1, 8 and 15 are incorporated respectively; further McNeely discloses the test commands can be created offline and subsequently communicated to the interpretive engine (col. 15, lines 31-34 "downloads the test to execution engine 400").

Claim Rejections - 35 USC § 103

16.　　The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17.　　**Claims 2, 7, 9, 14, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,117,411 to McNeely et al. (McNeely).**

18.   **Regarding Claims 2, 9 and 16:** The rejections of claims 1, 8 and 15 are incorporated respectively; further McNeely does not explicitly disclose the software tool stored locally on the same computer or machine.

19.   McNeely's background teaches that "The client/server framework allows a client to be located on any system in the network, even on the same system on which the server resides" (col. 3, lines 7-10).

20.   Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store the test software tool on the same computer or machine as McNeely's "Test Tools Server" (see Fig. 3).

21.   **Regarding Claims 7, 14 and 21:** The rejections of claims 1, 8 and 15 are incorporated respectively; further McNeely discloses a test software tool can be replaced with another test software tool (col. 13, lines 47-49 "a suitable GUI tester is added via a new package"), but does not explicitly disclose the test software tool can be removed.

22.   McNeely teaches "the test cases are independent of the number or types of devices under test" (col. 3, lines 56-57).

23.   Accordingly It would have been obvious to one of ordinary skill in the art at the time the invention was made to remove test software tools which had been replaced with new test software tools (col. 13, lines 47-49 "a suitable GUI tester is added").

Conclusion

24.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason Mitchell
4/10/07

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